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In re Application of	:	
SCHEIRER et al.	:	
Serial No.: 10/599,322	:	DECISION ON PETITION
PCT No.: PCT/IB05/50987	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 22 March 2005	:	
Priority Date: 02 April 2004	:	
Atty Docket No.: US040176US	:	
For: INTRACAVITY PROBE WITH	:	
CONTINUOUS SHIELDING OF	:	
ACOUSTIC WINDOW	:	

This decision is issued in response to applicant's "Petition When Inventor Refuses to Sign" filed 25 September 2006, which is being treated as a Petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor, Alan Hornberger.

BACKGROUND

On 22 March 2005, applicant filed international application PCT/IB05/50987 which claimed priority to a previous application filed 02 April 2004. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 02 October 2006.

On 25 September 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; a declaration of inventors; and the present petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor, Alan Hornberger.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or

her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items (1) and (4).

Regarding item (2) above, petitioner states that Alan Hornberger has refused to sign the application. Section 409.03(d) of the MPEP, **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner provided evidence that a bona fide attempt was made to present a copy of the application papers to the nonsigning inventor, however, the petition and accompanying papers does not provide first hand knowledge that the nonsigning inventor has refused to execute the declaration and the application. The statements made with regards to the efforts to reach Alan Hornberger constitutes secondhand knowledge, in that, the actions to which petitioner is averring to were conducted by Jill Peistrup.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Alan Hornberger, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Regarding item (3) above, a clear statement of the last known address of the nonsigning inventor has not been provided. In situations where an inventor does not execute the oath or declaration, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary. (See MPEP §605.03)

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a). Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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